



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,900	12/12/2000	Carlos O. Pinzon	05725.0595-00	5474
22852	7590	10/06/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER VENKAT, JYOTHSNA A	
			ART UNIT	PAPER NUMBER
			1619	
			MAIL DATE	DELIVERY MODE
			10/06/2008 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/733,900

Applicant(s)

PINZON ET AL.

Examiner

JYOTHSNA A. VENKAT

Art Unit

1615

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 355-368 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 355-368 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)

Paper No(s)/Mail Date: 4/21/08

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 1/15/08 has been entered.

Receipt is also acknowledged of response with regard to "request for information under 37 C.F.R. § 1.105" filed on 4/28/08 and also IDS filed on 4/21/08. Claims 355-368 are pending in the application and the status of the application is as follows:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 355-361 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is new matter rejection.**

There is no support in the specification for claims drawn to the species belonging to structuring polymer, which is “**ethylenediamine/stearyl dimer tallate copolymer**”.

Specification at page 12, ll 14-25 teaches:

“Non-limiting examples of an at least one polyamide polymer which may be used in the composition according to the present invention include the commercial products sold by Arizona Chemical under the names Uniclear 80 and Uniclear 100. These are sold, respectively, in the form of an 80% (in terms of active material) gel in a mineral oil and a 100% (in terms of active material) gel. These polymers have a softening point ranging from 88°C to 94 °C, and may be mixtures of copolymers derived from monomers of (i) C36 diacids and (ii) ethylenediamine, and have a weight-average molecular mass of about 6000. Terminal ester groups result from esterification of the remaining acid end groups with at least one alcohol chosen from cetyl alcohol and stearyl alcohol. A mixture of cetyl and stearyl alcohols is sometimes called cetylstearyl alcohol”.

The specification teaches the species, which can be formed from (i) C36 diacids and ethylenediamine and the terminal ester groups result from esterification of the remaining acid end groups can be with cetyl alcohol or the species can be formed from (ii) C36 diacids and ethylenediamine and the terminal ester groups result from esterification of the remaining acid end groups can be with stearyl alcohol or the species can be formed from (ii) C36 diacids and ethylenediamine and the terminal ester groups result from esterification of the remaining acid end groups can be with a mixture of cetyl and stearyl alcohols also known as cetylstearyl alcohol.

There is no support in the specification for species claimed in claims 355-361 since the species is a copolymer of ethylene diamine and tall oil dimer acid monomers end blocked with stearyl alcohol. Tall oil contains fatty acids mainly of palmitic acid, oleic acid and linoleic acid. See below for the definition of Tall oil.

From Wikipedia, the free encyclopedia

Tall oil, also called **liquid rosin** or **tallin**, is a viscous yellowish odorless liquid obtained as a byproduct of the steel process of acid anhydride manufacture. The name originated as an anglicization of Swedish "tallolja" ("pine oil").

Cude tall oil contains ca. 90% unsaturated fatty acids (8-10% saturated fatty acids) and its main components are palmitic acid and its isomers, stearic acid and its isomers, myristic acid and its isomers, lauric acid, and linoleic acid. It also contains some phenols and other distillates. It is obtained by the reaction of tall oil with caustic soda, with caustic soda content reduced to 10-20%. By further reduction of the caustic content to 1-10%, **tall oil fatty acid (TOFA)** can be obtained, which is cheap, consists mostly of oleic acid and is a source of valuable fatty acids. The caustic soda is a component of soaps, lubricants, and resins, and is an emulsifier. The acid is used as a detergent, an adjuvant, and an emulsifier for resins.

TOFA is a low-cost alternative to tall oil fatty acids for production of soaps and lubricants. When esterified with isocyanatolysis, it is used as a component of adhesives and obtained adhesives. Tall oil is also used in oil films as a component of oil-soluble films.

Thus tall oil acid is not a C36 dicarboxylic acid, therefore there is no support for the claimed species.

In response to Rule 105 request applicants submit as Exhibit 1, page 606 of the International Cosmetic Ingredient Dictionary and Handbook ("CTFA"), which recites that ethylenediamine/stearyl dimer dilinoleate copolymer is a copolymer of ethylenediamine and stearyl dimer dilinoleate monomers and further reciting that a trade name for ethylenediamine/stearyl dimer dilinoleate copolymer is Uniclear® and the same page also recites that ethylenediamine/stearyl dimer tallate copolymer is a copolymer of ethylenediamine and tall oil dimer acid monomers, end blocked with stearyl alcohol and further recites that a trade name for ethylenediamine/stearyl dimer tallate copolymer is Uniclear®. The cosmetic dictionary submitted to show support for the claimed specie is after the filing date of the instant application.

Applicants also submit as exhibit 2, a redacted version of confidential proprietary documents from the Assignee Company. See below

Réf. Commerciale	Fabricant / Distributeur
UNICLEAR 100 VG	REDACTED
(DGT) UNICLEAR 100 VG	
Nom chimique R.A.D :	CONDENSAT DIACIDE EN C36 HYDROGENE ETHYLENE DIAMINE, ESTERIFIE PAR ALCOOL STEARYLIQUE (PM: ENVIRON 4000) STABILISE (ANOX 20)
Nom INCI USA :	ETHYLENEDIAMINE/STEARYL DIMER DILINOLEATE COPOLYMER

The redacted document shows that Uniclear®100VG is also known as ethylenediamine stearyl dimer dilinoleate copolymer and this species is described since linoleic acid is 18 carboxylic diacid and the dimer acid is C36 carboxylic acid. This species is claimed in claims 362-368.

However, the first page of the redacted document does not state that Uniclear®100 V is ethylenediamine/tall oil dimer acid/stearyl alcohol copolymer (emphasis added), which is the species claimed in claims 355-361. Compare page 2 to page1.

Art Unit: 1615

REDACTED

Nom Chimique : CONDENSAT DIACIDE EN C36 HYDROGENE/ETHYLENE DIAMINE, ESTERIFIE PAR ALCOOL STEARYLIQUE

Nom CFTA :

REDACTED

Références commerciales

Références commerciales	Fournisseurs
UNICLEAR 100 V	REDACTED

REDACTED

Número de CAS	Nom CFTA substance	Nom européen substance	% sub.	Rôle	Type	Color index	% etiq.	N° cines
REDACTED	ETHYLENEDIAMINE/TALL OIL DIMER ACID/STEARYL ALCOHOL COPOLYMER			REDACTED				
	REDACTED							

Search on Arizona Chemical Company website showed the following:

Air Care / Personal Care Gellants

Product	Softening Point, C, Ring & Ball	Viscosity cps/mPa-s @ 160 C	Acid No.	Color, Gardner	Amine No.	Flash Point, F
Uniclear® 100	88-100	90-140	12	1-2	<1.0	520
Uniclear® 100LM	75-80	90-140	12	1-2	<1.0	520
Uniclear® 100VG*	88-98	100-160	12	1-3	<1.0	520
Sylvaclear™ C75V*	70-80	90-160	25	1-3	<1.0	508

* Vegetable dimer based resin

The softening point and viscosity are different for Uniclear ® 100 and Uniclear ® 100 VG. Search on Arizona Chemical Company website did not show softening point and viscosity for Uniclear ® 100 V described at top portion of page 1 of the redacted copy. There is no Uniclear ® 80 on the website.

Therefore, there is no support for the claimed species and claims 355-361 are drawn to new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 355-368 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims recite “at least one structuring polymer chosen from ethylenediamine/stearyl dimer tallate copolymer” or “at least one structuring polymer chosen from ethylenediamine/stearyl dimer dilinoleate copolymer”. The expression “chosen from” implies

more than one Markush member. There is only one copolymer therefore the expression “at least one” and “chosen from” lacks clarity and the claims do not particularly point out the subject matter which the applicant regards as his invention.

The expression “care product for skin or hair or lips” is unclear as to applicant intent. The specification describes various cosmetic products that are claimed in claim 355. Therefore, what is meant by “care products for skin, lip or hair”?

The same is true for “care or treatment composition for keratin fibers”. Specification describes various cosmetic products and does not describe any treatment composition. Treatment implies treating a condition or disease related to lips, skin or hair. Specification neither describes nor exemplifies any condition for keratin fiber or care composition for keratin fiber. The expression is ambiguous and lacks clarity.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 355-361 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,716,420 ('420) in view of U. S. Patent 5,289,363 ('363).

The instant application is claiming mascara or a make-up composition for keratin fibers comprising fatty phase, which comprises (i) ethylenediamine/stearyl dimer tallate copolymer and (ii) at least one oil-soluble cationic surfactant. Patent '420 is claiming method for making up eyelashes and method for making mascara comprising the same ethylenediamine/stearyl dimer tallate copolymer along with coloring agent, preservative, neutralized stearic acid, and PVP and glyceryl stearate. Patent ' 363 under examples 2-3 teaches mascara compositions using glyceryl stearate, coloring agent (iron oxide black), preservative, neutralized stearic acid (stearic acid and triethanolamine) and patent at col.4, ll 60-68 teaches various film formers and this includes claimed PVP. All these ingredients are used in mascara formulation and therefore it would be obvious to prepare mascara compositions and add the ingredients taught by patent '420 which have been used in mascara compositions.

Additionally, the expression "comprising" in the claims is inclusive of the unrecited ingredients claimed in the patent. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open- ended and does not exclude additional, unrecited elements or method steps. See, e.g., Mars Inc. v. H.J. Heinz Co., 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms containing' and mixture' are open-ended."). Invitrogen Corp. v. BiocrestMfg., L.P., 327

F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); Genentech, Inc. v. Chiron Corp., 112 F.3d 495, 501,42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim). In re Gray, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); Ex parte Davis, 80 USPQ 448,450 (Bd. App. 1948).

Claims 355-359 and 361 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1and 3 of U.S. Patent No. 6,835,399 ('399) in view of U. S. patent 5,945,095 ('095) .

The instant application is claiming mascara or a make-up composition for keratin fibers comprising a fatty phase, which comprises (i) ethylenediamine/stearyl dimer tallate copolymer; and (ii) at least one oil-soluble cationic surfactant. Patent '399 is claiming a method for lengthening the eyelashes comprising the same ethylenediamine/stearyl dimer tallate copolymer along with dispersion of polymer particles that is film-forming. Claim 1 of patent '399 is drawn to genus and this polymer of formula I anticipates the species claimed in instant application. Claim 3 of patent '399 is the same species claimed in the instant application. Patent '095 teaches dispersion of polymer particles in cosmetic compositions and using the polymeric particles dispersion in various cosmetic products. See col.1, ll 1-10, col.10, ll 33-40 and also the examples. It would be obvious to prepare mascara compositions and add the dispersion of polymeric particles taught by patent '095 which have been used various cosmetic compositions and use the mascara compositions for lengthening the eyelashes.

Additionally, the expression "comprising" in the claims is inclusive of the unrecited ingredients claimed in the patent. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms containing' and mixture' are open-ended."). *Invitrogen Corp. v. BiocrestMfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim). *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448,450 (Bd. App. 1948).

Claims 355-359 and 362-366 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,869,594 ('594) in view of U. S. patent 5,945,095 ('095) .

The instant application is claiming mascara or a make-up composition for keratin fibers or a make-up composition for keratinous fibers comprising a structured composition or a method for making a cosmetic composition comprising fatty phase, which comprises (i) ethylenediamine/stearyl dimer tallate copolymer or ethylenediamine/stearyl dimer dilinoleate copolymer (ii) at least one oil-soluble cationic surfactant. Patent '594 is claiming method for making up the eyelashes a comprising the same ethylenediamine/stearyl dimer tallate copolymer

or ethylenediamine/stearyl dimer dilinoleate copolymer along with isododecane, coloring agent and preservative. Making up of eyelashes claimed in the patent is same as mascara composition claimed in the instant application and make-up composition claimed in the instant application includes making up eyelashes claimed in the patent and method for making cosmetic composition for keratin fibers claimed in the instant application includes making up of eyelashes claimed in the patent. Patent '095 under example 7 teaches mascara composition using isoparaffin (isododecane, see col.5, ll 22-23) and also black iron oxide (pigments or coloring agent). It would be obvious to prepare mascara compositions comprising the two species and add isododecane as the fatty phase, coloring agent and preservative taught by patent '095 in cosmetic compositions which includes mascara since mascara compositions need coloring agent and fatty phase so that the polymer is soluble in the fatty phase and preservatives are added to improve the shelf life.

Additionally, the expression "comprising" in the claims is inclusive of the unrecited ingredients claimed in the patent. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term 'comprising,' the terms 'containing' and 'mixture' are open-ended."). *Invitrogen Corp. v. BiocrestMfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition 'comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are

essential, but other elements may be added and still form a construct within the scope of the claim). In re Gray, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); Ex parte Davis, 80 USPQ 448,450 (Bd. App. 1948).

Claims 355-358 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 and 4-6 of U.S. Patent No. 6,881,400 ('400) in view of U. S. patent 5,945,095 ('095) .

The instant application is claiming mascara or a make-up composition for keratin fibers or a make-up composition for keratinous fibers comprising a structured composition comprising a fatty phase which comprises (i) ethylenediamine/stearyl dimer tallate copolymer (ii) at least one oil-soluble cationic surfactant. Patent '400 is claiming a process for increasing the adhesion of make-up on eyelashes comprising the same ethylenediamine/stearyl dimer tallate copolymer along with coloring agent and preservative and (isododecane or silicone oil as the fatty phase in dependent claims). When mascara or make-up composition is applied to keratin fibers the composition adheres to the eyelashes and the claimed process is obvious. Patent '095 under example 7 teaches mascara composition using isoparaffin also black iron oxide (pigments or coloring agent). Patent at col.5, ll 20-23 teaches isododecane also known as isoparaffin and silicone. It would be obvious to prepare mascara compositions comprising the species claimed and add isododecane or silicone oil as the fatty phase, coloring agent and preservative taught by patent '095 in cosmetic compositions which includes mascara since mascara compositions need coloring agent and fatty phase so that the polymer is soluble in the fatty phase and preservatives are added to improve the shelf life and the compositions when applied to eyelashes increase the adhesion of make-up on eyelashes.

Additionally, the expression "comprising" in the claims is inclusive of the unrecited ingredients claimed in the patent. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms containing' and mixture' are open-ended."). *Invitrogen Corp. v. BiocrestMfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim). *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448,450 (Bd. App. 1948).

Claims 355-358 and 361-364 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,979,469 ('469) in view of U. S. patent 6,214,329 ('329) .

The instant application is claiming mascara or a make-up composition for keratin fibers or a make-up composition for keratinous fibers comprising a structured composition comprising a fatty phase, which comprises (i) ethylenediamine/stearyl dimer tallate copolymer or ethylenediamine/stearyl dimer dilinoleate copolymer (ii) at least one oil-soluble cationic surfactant. Patent '469 is claiming a method of making up eyelashes comprising applying to the eyelashes a mascara composition comprising same ethylenediamine/stearyl dimer tallate

copolymer or ethylenediamine/stearyl dimer dilinoleate copolymer along with inert filler (kaolin or PTFE), coloring agent and preservative and (isododecane as volatile solvent in dependent claim). Patent '329 teaches mascara compositions using isododecane at col.6, ll 59-60; pigments or coloring agent at col.9, ll 19-25 and fillers at col.9, ll 1-16. It would be obvious to prepare mascara compositions comprising the species claimed and add isododecane coloring agent and filler taught by patent '329 in mascara compositions.

Additionally, the expression "comprising" in the claims is inclusive of the unrecited ingredients claimed in the patent. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms containing' and mixture' are open-ended."). *Invitrogen Corp. v. BiocrestMfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim). In re Gray, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948).

Claims 355- 359 and 361 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 7,008, 619 ('619) in view of U. S. Patent 5,289,363 ('363).

The instant application is claiming a cosmetic composition or a make-up composition for keratin fibers or a method for make-up of a keratin material comprising fatty phase, which comprises (i) ethylenediamine/stearyl dimer tallate copolymer and (ii) at least one cationic surfactant. Patent '619 is claiming method for making up eyelashes and method for making mascara comprising the same ethylenediamine/stearyl dimer tallate copolymer along with coloring agent, preservative, neutralized stearic acid, and dependent claims are claiming PVP and glyceryl stearate. Method of making up eyelashes claimed in the patent is a cosmetic composition claimed in the instant application and it is also a make-up composition for keratin fibers claimed in the instant application. Patent '363 under examples 2-3 teaches mascara compositions using glyceryl stearate, coloring agent (iron oxide black), preservative, neutralized stearic acid (stearic acid and triethanolamine) and patent at col.4, ll 60-68 teaches various film formers and this includes claimed PVP. All these ingredients are used in mascara formulation and therefore it would be obvious to prepare mascara compositions and add the ingredients taught by patent '363 which have been used in mascara compositions.

Additionally, the expression "comprising" in the claims is inclusive of the unrecited ingredients claimed in the patent. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term 'comprising,' the terms 'containing' and 'mixture' are open-ended."). *Invitrogen Corp. v. BiocrestMfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition 'comprising' in a method claim indicates that the claim is open-ended and allows for additional steps.");

Genentech, Inc. v. Chiron Corp., 112 F.3d 495, 501,42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim). In re Gray, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); Ex parte Davis, 80 USPQ 448,450 (Bd. App. 1948).

Claims 355-358 and 362-365 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 13 and 15 of U.S. Patent No. 7,008,619 ('619) in view of U. S. Patent 6,214,329 ('329).

The instant application is claiming mascara or a make-up composition for keratin fibers comprising a fatty phase, which comprises (i) ethylenediamine/stearyl dimer tallate copolymer or ethylenediamine/stearyl dimer dilinoleate copolymer; and (ii) at least one oil-soluble cationic surfactant. Patent '619 is claiming a method of making mascara comprising including in mascara same ethylenediamine/stearyl dimer tallate copolymer or ethylenediamine/stearyl dimer dilinoleate copolymer along with inert filler (kaolin or PTFE), coloring agent and preservative and (isododecane as volatile solvent in dependent claim and silica in dependent claim). Patent '329 teaches mascara compositions using isododecane at col.6, ll 59-60 and pigments or coloring agent at col.9, ll 19-25 and fillers at col.8, ll 66-67 (silica) and col.9, ll 1-16 (kaolin). It would be obvious to prepare mascara compositions comprising the species claimed and add isododecane coloring agent and filler taught by patent '329 in mascara compositions.

Additionally, the expression "comprising" in the claims is inclusive of the unrecited ingredients claimed in the patent. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open- ended and does not

exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms containing' and mixture' are open-ended."). *Invitrogen Corp. v. BiocrestMfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim). In re Gray, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); Ex parte Davis, 80 USPQ 448, 450 (Bd. App. 1948).

Claims 355-356 and 362-363 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 17 of U.S. Patent No. 7,025,953 ('953).

The instant application is claiming a nail or a make-up composition for keratin fibers comprising a fatty phase, which comprises (i) ethylenediamine/stearyl dimer tallate copolymer or ethylenediamine/stearyl dimer dilinoleate copolymer; and (ii) at least one oil-soluble cationic surfactant. Patent '953 is claiming a process for making up nail composition comprising same ethylenediamine/stearyl dimer tallate copolymer or ethylenediamine/stearyl dimer dilinoleate. The species claimed in claims 3 and 17 of patent belong to polymer of formula I claimed in the patent and the species also belong to first polymer claimed in claim 1 of patent. The genus claimed in the patent anticipates the species claimed in the instant application.

Additionally, the expression "comprising" in the claims is inclusive of the unrecited ingredients claimed in the patent. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term 'comprising,' the terms 'containing' and 'mixture' are open-ended."). *Invitrogen Corp. v. BiocrestMfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition 'comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim). *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948).

Claims 356-357 and 363-364 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,025,953 ('953).

The instant application is claiming a make-up composition for keratin fibers comprising a fatty phase, which comprises (i) ethylenediamine/stearyl dimer tallate copolymer or ethylenediamine/stearyl dimer dilinoleate copolymer and (ii) at least one oil-soluble cationic surfactant. Patent '953 is claiming a composition comprising same ethylenediamine/stearyl dimer tallate copolymer or ethylenediamine/stearyl dimer dilinoleate along with oil soluble polymer chosen from alkyl celluloses and alkylated guar gums. The claimed compositions are species belong to "composition" claimed broadly in the patent.

The expression "comprising" in the claims is inclusive of the unrecited ingredients claimed in the patent, which is alkyl cellulose or alkylated guar gums.. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open- ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms containing' and mixture' are open-ended."). *Invitrogen Corp. v. BiocrestMfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501,42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim). *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448,450 (Bd. App. 1948).

Claims 355-359, 361-366 and 368 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 18-21, 28-29 and 30-35 of U.S. Patent No. 7,314,612 ('612).

The instant application is claiming a mascara, an eyeliner, a foundation, a lipstick, a blusher, a make-up-removing product, a make-up product for the body, an eye shadow, a face powder, a concealer product, a nail composition, a shampoo, a conditioner, an anti-sun product or a care product for the skin, lips, or hair or a make-up and /or care and /or treatment composition for keratin fibers or a treatment , care or make-up composition for keratin fibers or a method for care, make up or treatment of a keratin material comprising a fatty phase, which

comprises (i) ethylenediamine/stearyl dimer tallate copolymer or ethylenediamine/stearyl dimer dilinoleate copolymer and (ii) at least one oil-soluble cationic surfactant. Patent '612 is also claiming a mascara, an eyeliner, a foundation, a lipstick, a blusher, a make-up-removing product, a make-up product for the body, an eye shadow, a face powder, a concealer product, a nail composition, a shampoo, a conditioner, an anti-sun product or a care product for the skin, lips, or hair or a make-up and /or care and /or treatment composition for keratin fibers or a treatment, care or make-up composition for keratin fibers or a method for care, make up or treatment of a keratin material comprising a fatty phase, which comprises same ethylenediamine/stearyl dimer tallate copolymer or ethylenediamine/stearyl dimer dilinoleate copolymer along with gelling agent.

The expression "comprising" in the claims is inclusive of the unrecited ingredients claimed in the patent, which is gelling agent. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., Mars Inc. v. H.J. Heinz Co., 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms containing' and mixture' are open-ended."). Invitrogen Corp. v. BiocrestMfg., L.P., 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); Genentech, Inc. v. Chiron Corp., 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within

the scope of the claim). In re Gray, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); Ex parte Davis, 80 USPQ 448,450 (Bd. App. 1948).

Claims 355-358, 361-366 and 368 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 7,351,418 ('418) in view of U. S. patent 5,945,095 ('095) .

The instant application is claiming mascara or a make-up composition for keratin fibers comprising a fatty phase which comprises (i) ethylenediamine/stearyl dimer tallate copolymer or ethylenediamine/stearyl dimer dilinoleate copolymer; and (ii) at least one oil-soluble cationic surfactant. Patent is claiming a cosmetic composition comprising the same ethylenediamine/stearyl dimer tallate copolymer or ethylenediamine/stearyl dimer dilinoleate copolymer along with dispersion of polymer particles that is film-forming. Claim 1 of patent '399 is drawn to genus and this polymer of formula I anticipates the species claimed in instant application. Claim 1 of patent claims cosmetic composition and the different compositions claimed or the different products claimed in the instant application all belong to cosmetic compositions. Claim 5 of patent '399 is the same species claimed in the instant application. Patent '095 teaches dispersion of polymer particles in cosmetic compositions and using the polymeric particles dispersion in various cosmetic products. See col.1, ll 1-10, col.10, ll 33-40 and also the examples. It would be obvious to prepare mascara compositions and add the dispersion of polymeric particles taught by patent '095 which have been used various cosmetic compositions.

Additionally, the expression "comprising" in the claims is inclusive of the unrecited ingredients claimed in the patent. The transitional term "comprising", which is synonymous with

"including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms containing' and mixture' are open-ended."). *Invitrogen Corp. v. BiocrestMfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim). *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948).

Claims 355-358, 361-366 and 368 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 29-30 of U.S. Patent No. 7, 410, 636 ('636) in view of U. S. patent 6,491,931 ('931) .

The instant application is claiming mascara or a make-up composition for keratin fibers comprising a fatty phase, which comprises (i) ethylenediamine/stearyl dimer tallate copolymer or ethylenediamine/stearyl dimer dilinoleate copolymer and (ii) at least one oil-soluble cationic surfactant. Patent '636 is claiming a cosmetic composition comprising the same ethylenediamine/stearyl dimer tallate copolymer or ethylenediamine/stearyl dimer dilinoleate copolymer along with fibers. Claim 1 of patent '636 is drawn to genus and this polymer of formula I anticipates the species claimed in instant application. Claim 1 of patent claims composition. The different compositions claimed or the different products claimed in the instant

application all belong to compositions claimed in the patent. Claims 29-30 of patent '636 is the same species claimed in the instant application. Patent '931 teaches fibers in cosmetic compositions and using the fiber in keratin make up compositions. See col.2, ll 15-67 for fibers. It would be obvious to prepare mascara compositions and add fibers taught by patent '931 which have been used in various cosmetic compositions and these fibers make the compositions water resistant.

Additionally, the expression "comprising" in the claims is inclusive of the unrecited ingredients claimed in the patent. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms containing' and mixture' are open-ended."). *Invitrogen Corp. v. BiocrestMfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim). In *re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948).

Non-patent literature from Arizona Chemical Company titled "Formulating Personal Care Products with Polyamide Gellants" is pertinent art. The publication date is not known to the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1615

/MP WOODWARD/
Supervisory Patent Examiner, Art Unit 1615

/George C. Elliott, Ph.D./
Director, Technology Center 1600